

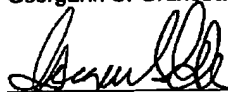
JAN 30 2006

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Georgann S. Grunebach (Name of Applicant, Assignee or Registered Representative)



(Signature)

January 30, 2006 (Date of Signature)

Reg. No. 43,179

Customer Number 020991

**Patent**  
**PD-200352A****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of

Erin H. Sibley

Serial No. 09/844,976

Group Art Unit: 2617

Filed: April 26, 2001

Examiner: Ustaris, Joseph G.

For: DIGITAL OVER-THE-AIR COMMUNICATION SYSTEM FOR USE WITH  
ANALOG TERRESTRIAL BROADCASTING SYSTEM**BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following Appeal Brief is submitted in response to the Notice of Appeal filed  
December 6, 2005.

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**I. Real Party in Interest**

The real party in interest in this matter is The DirecTV Group, Inc of El Segundo, California which is 34 percent owned by Fox Entertainment Group, which is approximately 82 percent owned by The News Corporation, Limited.

**II. Related Appeals and Interferences**

There are no other known appeals or interferences which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

**III. Status of the Claims**

Claims 1-12 stand rejected in the Final Office Action. Claims 13-17 have been withdrawn from consideration.

**IV. Status of Amendments**

There have been no amendments filed subsequent to the Final Office Action mailed October 17, 2005.

**V. Summary of Claimed Subject Matter**

At a high level, the present invention is best illustrated in Figure 1. Claim 1 is directed to a system 10 for distributing electronic content as it is described in lines 1-3 on paragraph 30. The system further includes a network operations center 12 that uplinks electronic content to the satellite as described in line 3 of paragraph 30.

The network operations center 12 is described in more detail in lines 1-4 of paragraph 31.

The system further includes an over-the-air broadcast center 16 described in lines 1-11 of paragraph 32. The over-the-air broadcast center receives electronic content from the satellite and generates digital over-the-air electronic content during a vertical blanking interval 106 of an analog broadcast signal 102. The vertical blanking interval

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106 and the analog broadcast signal 102 are described in Figure 4 and in lines 1-16 of paragraph 45.

A user appliance 18 receives the electronic content. The user appliance is described in lines 1-13 of paragraph 34.

Claim 2 describes the over-the-air broadcast center being coupled to a stratospheric platform. Claim 3 describes the over-the-air broadcast center as being coupled to a cell tower. Claim 4 describes the over-the-air broadcast center being coupled to a TV broadcast tower. Each of the examples are set forth in Figures 2-4 and find support in lines 2-5 of paragraph 33.

Claim 5 recites that the electronic content comprises digital audio signals and Claim 6 recites that the electronic content comprises video. Such content is mentioned in various places throughout the application, including the last two lines of paragraph 48 and the last four lines of paragraph 58.

Claim 7 recites that the user appliance is fixed and Claim 8 recites that the user appliance is mobile. This is mentioned in the second line of paragraph 8 and the second line of paragraph 11 of the present application. Also, this is described in the first three lines of paragraph 41.

Claim 9 is directed to a method of distributing electronic content that includes the steps of uplinking a plurality of electronic content packages to a satellite 14 as described in lines 3-5 of paragraph 36. The method further includes receiving the electronic content packages from the satellite. This is described in the first two lines of paragraph 32.

The method of Claim 9 further includes over-the-air broadcasting the electronic content packages during a vertical blanking interval of an analog television broadcast signal from a terrestrial over-the-air broadcast center 16. This is described in lines 1-10 of paragraph 33.

The method further includes receiving the electronic content packages through a user appliance as is described in lines 1-6 of paragraph 34. Claims 10, 11 and 12 recite

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respectively that the step of receiving comprises over-the-air broadcasting from a stratospheric platform, a cell tower, and a TV broadcast tower. These structures are described in paragraph 33, lines 2-5.

Claims 13-17 have been withdrawn from consideration.

## **VI. Grounds of Rejection to be Reviewed on Appeal**

The following issues are presented in this appeal:

Whether Claims 1-7 and 9-12 are obvious under 35 U.S.C. §103(a) as being unpatentable over *Hendricks* (6,160,989) in view of *Kim* (6,556,248)

Whether Claim 8 is obvious under 35 U.S.C. §103(a) as being unpatentable over *Hendricks* in view of *Kim* as applied to Claims 1-7 and 9-12 above, and in further view of *Owa* (6,711,379)

## **VII. Argument**

### **The Rejection of Claims 1-7 and 9-12 as being unpatentable under §103(a) over *Hendricks* in view of *Kim***

#### **Claim 1**

The present invention is essentially a rebroadcasting system that rebroadcasts electronic content received from a satellite over-the-air during a vertical blanking interval of an analog broadcast signal. That is, the electronic content is additional to the information already broadcast in the regular or primary part of the signal. The *Hendricks* reference is directed to network controller for cable television delivery systems. The *Hendricks* reference specifically mentions that the teachings may be applied to "home telephone lines, cellular networks, fiber optics, Personal Communication Networks and similar technology for transmitting to the home" as set forth in Col. 7, lines 30-34. Applicant agrees that both a digital and analog tuner are illustrated as elements 3 and 5 of Fig. 2. Applicant agrees that an operations center satellite and a network controller are illustrated. However, as the Examiner sets forth, no broadcasting of additional

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information over a vertical broadcasting interval of an analog broadcast signal is taught in the *Hendricks* reference.

The *Kim* reference is set forth for a system that utilizes the vertical blanking interval of an analog broadcast system to deliver various data. Applicant agrees that the vertical blanking interval in *Kim* is used for various data. No teaching is provided for a terrestrial-based digital over-the-air broadcast center that uses electronic content received from a satellite which then broadcasts the electronic content during the vertical blanking interval.

The Examiner states, "it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the cable headend disclosed by *Hendricks* to be able to transmit some of the data or 'electronic content' within the VBI of an 'analog broadcast signal', as taught in *Kim*, in order to efficiently use the bandwidth available between the headend and user terminals thereby increasing the efficiency of the overall system." Applicant respectfully submits that the Examiner is forming a hindsight reconstruction of the present invention using the teachings of the prior art.

It is improper, in determining whether a person of ordinary skill in the art would have been led to this combination of references, simply to "[use] that which the inventor taught against the teacher." W. L. Gore v. Garlock Inc., 721 F. 2d 1540, 1553, 220 USPQ 301312-13 (Fed.Cir.1983). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. Clearly, no support, motivation or incentive is provided by the two cited references for such a combination. It is well established that the prior art must make a suggestion of, or provide an incentive for a claimed combination of elements to establish a *prima facie* case of obviousness. See In re Oetiker, 24 U.S.P.Q.2d 1443, 1446 (Fed.Cir. 1992); Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pt. App. 1985). In this instance, however, no support, motivation, or incentive is provided by the two cited references for the combination

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proposed by the Examiner. The *Hendricks* reference is clearly used as a generic communication system with no need to broadcast additional information. Only conventional broadcasting without the extra content is set forth. Therefore, Appellant respectfully requests the Board to reverse the Examiner's position with respect to Claim 1.

**Claim 2**

The Examiner points to the satellite as a stratospheric platform. However, those skilled in the art will recognize that a stratospheric platform may be a variety of devices but are within the earth's atmosphere. Stratospheric platforms do not extend to the region covered by satellites. The *Hendricks* reference merely describes that the satellite downlinks information to a network controller. It should be recognized that the terrestrial over-the-air broadcast center is broadcasting digital over-the-air electronic content which is not the same as the satellite broadcasting the electronic content. Therefore, Claim 2 is very different than that of Figure 1 of the *Hendricks* reference. Appellant therefore respectfully requests the Board to reverse the Examiner's position with respect to Claim 2.

**Claim 3**

Claim 3 recites that the over-the-air broadcast center is coupled to a cell tower. Again, Figure 1 of *Hendricks* illustrates a network controller and not a cellular tower. Therefore, Appellant respectfully requests the Board to reverse the Examiner's position with respect to Claim 3 as well.

**Claim 4**

Claim 4 recites that the over-the-air broadcast center is coupled to a TV broadcast tower. A TV broadcast tower is also not illustrated since the *Hendricks* reference primarily deals with a cable headend and rebroadcasting over-the-air digital electronic

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content during a vertical blanking interval of an analog broadcast signal. Appellant therefore respectfully requests the Board to reverse the Examiner's position with respect to Claim 4 as well.

### Claims 5 and 6

Claim 5 recites that the electronic content comprises digital audio signals and Claim 6 recites that the electronic content comprises video. Appellant respectfully submits that Claims 5 and 6 stand or fall together with Claim 1.

### Claim 7

Claim 7 recites that the user appliance is fixed. Because rebroadcasting using digital over-the-air electronic content from a terrestrial over-the-air broadcast center is not taught or suggested in the *Hendricks* reference, Appellant respectfully submits that Claim 7 is also allowable for the same reasons set forth above.

### Claim 9

Claim 9 is similar to Claim 1 in method form. Claim 9 recites the steps of uplinking a plurality of electronic content packages to a satellite, receiving the electronic content packages from the satellite, over-the-air broadcasting of the electronic content packages during a vertical blanking interval of an analog television broadcast signal from a terrestrial over-the-air broadcast center and receiving electronic content packages through a user appliance. Thus, Claim 9 is similar to Claim 1 in that electronic content packages are broadcasted during the vertical blanking interval of a television broadcast signal. The television broadcast signal is provided from a terrestrial over-the-air broadcast center. Therefore, Appellant respectfully requests the Board to reverse the Examiner's position with respect to Claim 9 as well.

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**Claim 10**

Claim 10 recites a stratospheric platform. As mentioned above with respect to Claim 2, no stratospheric platform is set forth in the references. Appellant respectfully requests the Board to reverse the Examiner's position for the same reasons set forth above with respect to Claim 2.

**Claim 11**

Claim 11 recites a cell tower in a similar manner to that described above with respect to Claim 3. Appellant respectfully requests the Board to reverse the Examiner's position with respect to Claim 11 as well.

**Claim 12**

Claim 12 recites a TV broadcast tower in a similar manner to that described above with respect to Claim 4. Appellant respectfully requests the Board to reverse the Examiner's position with respect to Claim 12 as well.

**The Rejection of Claim 8 under §103(a) over *Hendricks* in view of *Kim* in further view of *Owa***

**Claim 8**

The Examiner points to Figure 1, reference numerals 23 and 24, and Col. 7, lines 21-35, for a mobile device. Appellant admits that a mobile device is illustrated in the *Owa* reference. The mobile device receives information or signals from a satellite. Although various sources such as a ground wave broadcast and satellite broadcast are described, no teaching or suggestion is provided for the elements missing from Claim 1. Namely, no teaching or suggestion is provided for a terrestrial over-the-air center that generates digital over-the-air electronic content during a vertical blanking interval of an analog broadcast signal. Appellant therefore respectfully request the Board to reverse the Examiner's position with respect to Claim 8 as well.



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**VIII. Claims Appendix**

A copy of each of the claims involved in this appeal, namely Claims 1-12 is attached as a Claims Appendix.

**IX. Evidence Appendix**

None.

**X. Related Proceedings Appendix**

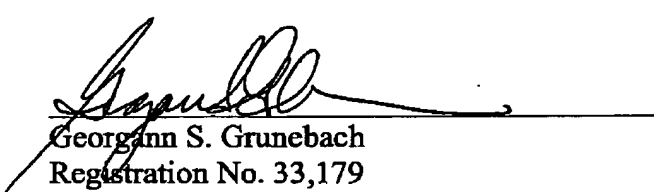
None.

**XI. Conclusion**

For the foregoing reasons, Appellant respectfully requests that the Board direct the Examiner in charge of this examination to withdraw the rejections.

Please charge any fees required in the filing of this appeal to deposit account 50-0383.

Respectfully submitted,



Georgann S. Grunebach  
Registration No. 33,179  
Attorney for Appellants

Date: January 30, 2006

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Telephone No. (310) 964-4615

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**CLAIMS APPENDIX**

1. A system of distributing electronic content comprising:  
a satellite;  
a network operations center uplinking electronic content to said satellite;  
a terrestrial over-the-air broadcast center receiving said electronic content from said satellite and generating digital over-the-air electronic content during a vertical blanking interval of an analog broadcast signal; and  
a user appliance receiving said electronic content.
2. A system as recited in claim 1 wherein said over-the-air broadcast center is coupled to a stratospheric platform.
3. A system as recited in claim 1 wherein said over-the-air broadcast center is coupled to a cell tower.
4. A system as recited in claim 1 wherein said over-the-air broadcast center is coupled to a TV broadcast tower.
5. A system as recited in claim 1 wherein said electronic content comprises digital audio signals.
6. A system as recited in claim 1 wherein said electronic content comprises video.
7. A system as recited in claim 1 wherein said user appliance is fixed.
8. A system as recited in claim 1 wherein said user appliance is mobile.

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9. A method of distributing electronic content comprising the steps of:  
uplinking a plurality of electronic content packages to a satellite;  
receiving the electronic content packages from the satellite;  
over-the-air broadcasting the electronic content packages during a vertical  
blanking interval of an analog television broadcast signal from a terrestrial over-the-air  
broadcast center; and  
receiving the electronic content packages through a user appliance.

10. A method as recited in claim 9 wherein the step of receiving over-  
the-air broadcasting comprises over-the-air broadcasting from a stratospheric platform.

11. A method as recited in claim 9 wherein the step of receiving over-  
the-air broadcasting comprises over-the-air broadcasting from a cell tower.

12. A method as recited in claim 9 wherein the step of receiving over-  
the-air broadcasting comprises over-the-air broadcasting from a TV broadcast tower.

JAN 30 2006

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Examiner: Joseph G. Ustaris

Supervisory Examiner: James Groody

UNITED STATES PATENT AND TRADEMARK  
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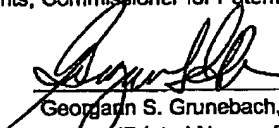
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Georgann S. Grunebach, Reg. No. 33,179  
(Printed Name of Depositor)

January 30, 2006  
(Date of Signature)

Re: Serial No. 09/844,976  
Filing Date: April 26, 2001

Attorney Docket No. PD-200352A

Please find attached:

- FEE TRANSMITTAL FORM PTO/SB/17 (1 page in duplicate)
- BRIEF ON APPEAL (11 pages)

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**FEE TRANSMITTAL**  
**For FY 2006**☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500

**Complete if Known**

Application Number	09/844,976
Filing Date	April 26, 2001
First Named Inventor	Erin H. Sibley
Examiner Name	Ustaris, Joseph G.
Art Unit	2817
Attorney Docket No.	PD-200352A

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**FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
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- 20 or HP =	x	=	
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HP = highest number of total claims paid for, if greater than 20.

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
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- 3 or HP =	x	=	
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**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

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**4. OTHER FEE(S)**

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Fees Paid (\$)

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**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent) 33,179	Telephone (310) 964-4615
Name (Print/Type)	Georgann S. Grunebach	Date January 30, 2006	

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